

Applicant: Gary K. Schwartz
U.S. Serial No.: 10/693,301
Filed: October 24, 2003
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REMARKS

Claims 31-38 and 41-42 are pending in this application. By this Amendment, Applicant has hereinabove amended claim 31 in order for the claim to be better defined. The amended claim 31 is fully supported by the specification and there is no issue of new matter. Accordingly, Applicant respectfully requests the entry of this Amendment. Upon entry, claims 31-38 and 41-42 will be pending and under examination.

Response to Examiners Argument

Applicant hereby acknowledges the Examiners comment stating that Exhibits A and B were not included with the January 31, 2006 Amendment in Response to October 31, 2005 Office Action. However, Applicant respectfully submits that both Exhibit A and B were included with the January 31, 2006 Amendment in Response to October 31, 2005 Office Action. See return receipt postcard as Exhibit A (1 page). Applicant hereby re-attaches US Patent No. 6,444,638 as Exhibit B (59 pages) for the Examiners reference. If the Examiner would like a copy of the previously sent Exhibit A (US Patent NO. US 5,821,072) Applicant's undersigned attorney's office will send the Examiner a copy.

Claim Rejections Under 35 U.S.C. § 112, first paragraph

The Examiner has rejected Claim 34 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description of the requirement. The Examiner stated that the claim(s) contain subject matter, which was not described in the specification in such a way as to reasonable convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. Applicant respectfully traverses the about ground of rejection.

Claim 34 recites: The method of claim 33, further comprising a protein kinase C inhibitor. The instant specification incorporates by reference U.S. Pat. No. 6,444,638 which was obtained by the named inventor of the present application and provides a method of screening protein kinase C inhibitors capable of potentiating apoptosis in tumor cells (instant specification, p.16, ll. 22-34; see also the 638' patent, col.2, ll. 16-18). Applicant submits that the instant specification, as well as U.S. Pat. No. 6,444,638, have provided a number of representative protein kinase C inhibitors (instant specification, p.16, ll. 25-32; see also the 638' patent, col.3, ll. 4-9; col.8, ll. 33-57). Please refer to U.S. Pat. No. 6,444,638. See Exhibit B.

The Examiner stated that the court has determined that the disclosure of two chemical compounds within a subgenus did not describe the subgenus. However, Applicant submits that the present specification has clearly described a representative numbers (not only two) of protein kinase C inhibitors. In view of the disclosure on a number of exemplary protein kinase C inhibitors and the level of skill in the art, Applicant submits that the present disclosure has conveyed with reasonable clarity to those skilled in the art that the Applicant, at the time the application was filed, had possession of the claimed invention. Accordingly, Applicant respectfully requests the rejection of claim 34 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claim Rejections Under 35 U.S.C. § 102 (b)

The Examiner has rejected Claims 31-34 under 35 U.S.C. § 102(b) as being anticipated by Hong-fen et al. (2001) as

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evidenced by Xu et al. (1994) and Das et al. (1995). Applicant respectfully traverses.

The Examiner contends that Hong-fen et al. teach the treatment of solid tumors comprising administering to rats an effective amount of *Coptis chinensis* extract. Applicant submits that Hong-fen et al. teach the use of ACNO that contains *Coptis chinensis*, wherein ACNO was first dissolved in boiling water, then was mixed with standard powdered rodent food (p.1949, paragraphs 2.2-2.3).

In contrast, the present invention teaches a different preparation of Huanglian (*Coptis chinensis*). Huanglian was first boiled in water at 100°C for 1 hour, then insoluble material was removed by filtration. The remaining aqueous solution was subsequently boiled to dryness, and the resulting dry power was dissolved in water for subsequent use (see p.17, Example 1). Hence, the present invention teaches the use of an aqueous heat extractable fraction of *Coptis chinensis* extract.

Claim 31 has been amended to recite "an effective amount of aqueous heat extractable fraction of *Coptis chinensis* extract". Applicant submits that Hong-fen et al. only teach dissolving ACNO comprising *Coptis chinensis* in boiling water. Hong-fen et al. do not teach or suggest the use of an aqueous heat extractable fraction of *Coptis chinensis* extract as described and claimed herein. Since Hong-fen et al. do not teach or suggest each and every aspect of the present invention, Hong-fen et al. do not anticipate claim 31 and its dependent claims of the present invention. Accordingly, Applicant respectfully requests that the rejection of claims 31-34 under 35 U.S.C. § 102(b) be withdrawn.

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Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 31-38, 41 and 42 under 35 U.S.C. 103(a) as being unpatentable over Hong-Fen et al. (2001) in view of Xinxian 6,290,995 and Alloatti et al. (1998).

As discussed above, the primary reference Hong-Fen et al. do not teach or suggest a limitation of the present invention, namely, "an effective amount of aqueous heat extractable fraction of *Coptis chinensis* extract". Neither Xinxian nor Alloatti et al. was cited to provide such limitation. Xinxian was cited to teach that taxol is an anti-cancer drug that has the characteristic of promoting the assembly of microtubules (instant Office Action, p.6), whereas Alloatti et al. was cited to teach the use of taxol and taxol-analogs as a known anti-cancer treatment that acts to inhibit microtubule disassembly (instant Office Action, p.7). Therefore, the combined teaching of Hong-Fen et al. with Xinxian and Alloatti et al. does not teach or suggest each and every aspect of the present invention, and claim 31 and its dependent claims of the present invention are not obvious in view of the combination of Hong-Fen et al. with Xinxian and Alloatti et al. Accordingly, Applicant respectfully requests that the rejection of claims 31-38, 41 and 42 under 35 U.S.C. 103(a) be withdrawn.

CONCLUSION

In summary, Applicant believes that all grounds of rejections have been addressed and earnestly requests the Examiner to place this application in condition for allowance.

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If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891. Conversely, authorization is also hereby given to credit the amount of any overpayment to Deposit Account No. 50-1891.

Respectfully submitted,

Albert Wai Kit Chan

I hereby certify that this paper is being facsimile-transmitted to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Fax No.: (571) 273-8300

on the date shown below.

Albert Wai Kit Chan 5/19/06
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Exhibit A

Applicant: Gary K. SCHWARTZ
Date: January 31, 2006

File No.: 702-A-US

Kindly acknowledge receipt of the accompanying

AMENDMENT IN RESPONSE TO OCTOBER 31, 2005 OFFICE ACTION for Gary K. SCHWARTZ, U.S. Serial No. 10/693,301, Filed October 24, 2003, for SCREENING, QUANTITATION AND IDENTIFICATION OF ACTIVE INGREDIENTS IN NATURAL PRODUCTS, including Exhibits A-G.

by placing your receiving date stamp hereon and returning to us.

Applicant: Gary K. SCHWARTZ
Date: January 31, 2006

File No.: 702-A-US

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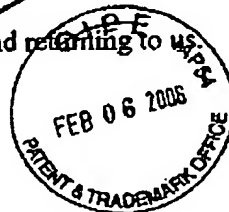


Exhibit B